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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,893	11/19/2001	Jonathan J. Hull	015358-007500US	1603
20350	7590	08/27/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BAUTISTA, XIOMARA L	
		ART UNIT	PAPER NUMBER	
		2179	8	
DATE MAILED: 08/27/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/001,893	HULL ET AL.	
	Examiner	Art Unit	
	X L Bautista	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 November 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-28 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 3/20/02 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6 & 7</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The attempt to incorporate subject matter into this application by reference to "No. __ / __." is improper because a serial number and filing date is needed for each application incorporated by reference.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 9-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9-15 recite a paper document. These claims do not truly fit any of the four statutory classes of invention, "process, machine, manufacture, or composition matter." They are not even held upon a computer-readable medium, as discussed in the Guidelines for examination, 1995. The claims recite nothing more than information, having some potential use to a computer capable of reading and interpreting them, in a manner analogous to the information content of printed matter, long held to be non-statutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1-4, 6, 7, 9, 10, 12-14, 16-19, 21, 22, and 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Schelling et al (US 5,706,097).**

Claims 1, 9, 16, and 24:

Schelling discloses a method for identifying images and sound recordings (multimedia) on a digital recording medium. The recording medium has individually addressable digital data files containing still images, motion sequences and sound sequences, an index print (coversheet) having a

Art Unit: 2173

plurality of index images representing the still images, motion sequences and sound sequences on the digital recording medium. Schelling teaches that the index print may be used for printing an image (thumbnail) of the document (page, index print), (abstract; col. 1, lines 58-67; col. 2, lines 1-14, 43-67; col. 4, lines 57-67; col. 5, lines 6-12).

Claims 2, 13, 17, and 25:

See claim 1. Schelling teaches printing text information on the index print for each image, wherein the text information is extracted from the document information (col. 5, lines 1-5, 15-16).

Claims 3, 18, and 26:

See claim 1. Schelling teaches printing a user-selectable identifier on the index print for each image printed on the index, wherein the identifier enables user access to multimedia information (col. 4, lines 57-67; col. 5, lines 13-14).

Claims 4, 14, 19, and 27:

See claim 1. Schelling teaches printing a matter descriptor such as a title identifying the subject matter of the data file (col. 5, lines 1-3).

Claims 6, 12, and 21:

See claims 2 and 3. Schelling teaches an index print having video frames extracted from video information and text information extracted from

the document (col. 4, lines 57-67; col. 5, lines 13-14).

Claims 8, 11, and 23:

See claim 1. Schelling teaches an indicator icon that indicates files containing sound and a text message describing the data file. Shelling illustrates text relating to (fig. 1) a sound recording of a person's (i.e. Grandma's) voice (col. 2, lines 62-67; col. 3, lines 10-29).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 5, 15, 20, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schelling* and *Yamaura* (US 5,857,185).**

Claims 5, 15, 20, and 28:

Schelling teaches that index codes for addressing the digital data files containing the images are assigned and appended to the files (col. 3, lines 1-39) but it does not teach printing a frequency count for indicating the number of times that information is located on the page. However, Yamaura discloses a method and system for searching and representing search results

that displays results using a display attribute that corresponds to the attribute of the string in each document. The display attribute varies in accordance with the frequency of occurrence of the searched string in each document. Yamaura teaches that the frequency of occurrence may be numerically displayed by the side of each of the listed documents (abstract; col. 1, lines 50-59; col. 2, lines 24-29; col. 3, lines 38-40; col. 4, lines 20-33, 62-67; col. 8, lines 39-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schelling's method for identifying images to include Yamaura's teaching of displaying a frequency count because as Yamaura says, it is helpful information for determining which document is optimum as a result of searching among a list of documents.

8. Claims 7, 10, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schelling and Gibbon et al* (US 6,098,082).

Claims 7, 10, and 22:

See claim 6. Schelling does not teach that the multimedia document includes printed closed-caption text information. However, Gibbon discloses a method for providing a compressed rendition of a video program in a format suitable for electronic searching and retrieval on the WWW. Gibbon

Art Unit: 2173

teaches pictorial transcripts that are compact representations of video programs which are automatically generated by selecting representative frames or images from the video program and combining them with a second media component such as audio or text which is associated with each representative frame (abstract; col. 1, lines 55-67; col. 2, lines 1-15; col. 3, lines 10-15). Gibbon teaches that a printed rendition of closed-captioned text may be provided. The printed rendition is a pictorial transcript in which each representative frame is printed with a caption containing the portion of the closed-caption text corresponding to the scene from which the representative frame is taken (col. 3, lines 16-22). Thus, it would have been obvious to a person having ordinary skill in the art at the time of invention to modify Schilling to include Gibbon's teaching of printing closed-caption text because it provides a printable visual presentation of the sound associated with the image (frame) of interest; therefore, close captioning is not only visible on a TV receiver designed to display it but it is also visible when being printed on paper.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2173

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X L Bautista whose telephone number is (703) 305-3921. The examiner can normally be reached on Monday-Thursday (8:00-18:00), Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



X L Bautista
Patent Examiner
Art Unit 2173

xlb
21 June 2004